

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte PETER J. BECKAGE

Appeal No. 2003-0242
Application No. 09/484,604

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 32 and 43. Claims 33 to 42, the only other claims pending in this application, have been withdrawn from consideration.

We REVERSE.

BACKGROUND

The appellant's invention relates to a method and apparatus for determining chemical mechanical polishing pad conditioner effectiveness (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Sandhu et al. (Sandhu)	5,036,015	July 30, 1991
Birang et al. (Birang)	5,743,784	Apr. 28, 1998

Claims 21 to 32 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims 1 to 32 and 43 stand rejected under 35 U.S.C. § 103 as being unpatentable over Birang in view of Sandhu.

Claims 1 to 32 and 43 stand rejected under 35 U.S.C. § 103 as being unpatentable over Sandhu in view of Birang.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 9, mailed May 21, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 8, filed March 26, 2002) and reply brief (Paper No. 10, filed July 29, 2002) for the appellant's arguments thereagainst.

OPINION

Initially we note that the restriction issue raised by the appellant on pages 3, 9 and 10 of the brief relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not further review this issue.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 21 to 32 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner's rational for this rejection is set forth in the answer (pp. 3-4) as follows:

the use of the terminology "adapted to" makes the claims vague and indefinite because the scope of the claims can not be ascertained, since it has been held the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

The use of the terminology "adapted to" in claim 21 does not render claims 21 to 32 vague and indefinite since the scope of the claims can be ascertained. As set forth by the examiner, the recitation that an element is "adapted to" perform a function is a limitation which requires only that the structure be able to perform the function. As

such, the scope of the claims can be ascertained with a reasonable degree of precision and particularity.

For the reasons set forth above, the decision of the examiner to reject claims 21 to 32 under 35 U.S.C. § 112, second paragraph, is reversed.

The obviousness rejections

We will not sustain the rejection of claims 1 to 32 and 43 under 35 U.S.C. § 103 as being unpatentable over Birang in view of Sandhu or the rejection of claims 1 to 32 and 43 under 35 U.S.C. § 103 as being unpatentable over Sandhu in view of Birang.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

The teachings of the applied prior art (i.e., Birang and Sandhu) have been adequately set forth in the brief and answer. In our opinion, the combined teachings of the applied prior art would not have suggested the claimed subject matter. In that

regard, absent the use of impermissible hindsight,¹ we fail to discern any suggestion, incentive or motivation in the applied prior art to combine the teachings thereof to arrive at the claimed invention. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The applied prior art must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). In this case, the examiner's alleged motivations as set forth in the obviousness rejections under appeal (answer, pp. 4-6) are, in our belief, based on the appellant's disclosure and not from the teachings of the applied prior art. In our view the combined teachings of the applied prior art would have suggested a system in which semiconductor wafers are polished as taught by Sandhu and that the polishing pad of Sandhu be thereafter conditioned as taught by Birang, not the claimed invention.

¹ The use of hindsight knowledge derived from the appellant's own disclosure to support an obviousness rejection under 35 U.S.C. § 103 is impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

On page 9 of the answer, the examiner asserts that Sandhu teaches a means of measuring the surface friction "equivalent" to that of Birang, thus implying that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have substituted Sandhu's means of measuring the surface friction for Birang's means of measuring the surface friction. We do not agree that Sandhu teaches a means of measuring the surface friction "equivalent" to that of Birang. In that regard, Sandhu teaches a means of measuring the surface friction which relies on a change in the coefficient of friction between the wafer 10, polishing slurry 18, and polishing platen 16 to change the load or amperage draw of the drive motors 26, 28. Specifically, as the oxide coating of a wafer 10, as shown in Figure 1 of Sandhu, is removed to the plane of the tops of the IC devices the coefficient of friction will change and that change is detected by a different amperage draw of the current meters 22, 24. Since no such "equivalent" change occurs in the conditioning process of Birang (i.e., neither the conditioning head 12 nor the polishing pad 14 undergoes an abrupt change in the coefficient of friction as when the oxide coating of a wafer 10 is removed to the plane of the tops of IC devices as in Sandhu), there is no suggestion, incentive or motivation in the applied prior art to combine the teachings thereof to arrive at the claimed invention. The mere fact that the prior art could be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior

art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 32 and 43 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 21 to 32 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 1 to 32 and 43 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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